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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,343	03/03/2004	Mitsuhiro Tominaga	12401-3	4542

7590 02/21/2008
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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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02/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/792,343	Applicant(s) TOMINAGA, MITSUHIRO	
	Examiner Mark A. Osele	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,10-12,14-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10-12,14-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 10-12, 14-17, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nose et al. (US 5,685,944) in view of Mendelovich et al. (US 5,735,999), Inagaki et al. (US Publication 2002/0179237), Akemi et al. (US 5,505,306), the admitted prior art, and Sosa et al. (US 5,403,556). Nose et al. discloses a transfer tool comprising a housing (Figure 2, casing C, case members C1 and C2) having an interior surface; and ribbon substrate (Figure 1, film transfer ribbon R) that travels inside the housing, the ribbon substrate being coated with an adhesive coating film to be transferred from the ribbon substrate (column 10, lines 23-27) onto the targeted object when the ribbon substrate is pressed onto the targeted object, wherein after film transfer, the adhesive film breaks near an end of the transferred length when the ribbon substrate is pulled away from the targeted object (Fig. 15). Nose et al. does not disclose a transfer tool wherein the interior surface of the housing is roughened at least in a region wherein the coating film on the ribbon substrate may contact the interior surface of the housing.

Mendelovich et al. discloses a transfer tool wherein the interior surface of the housing includes multiple bar projections, 66, wherein each bar projection has a line of points higher than any other portions thereof in its configuration. The projections are located at least in a region wherein adhesive elements on a carrier tape may contact the interior surface of the housing (Figure 7) to prevent the adhesive tape from undesirably sticking to the interior surface of the housing (column 5, lines 1-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the transfer tool of Nose et al. to include projections on the interior surface of the housing as suggested by Mendelovich et al. to prevent the coating film from adhering to the interior surface of the housing. The references as combined fail to show the multiple projections to each have one point higher than any other portions thereof.

Inagaki et al. shows that projections to limit adhesion can be cylindrical, such as those of Mendelovich et al., or spherical or conical, both of which have a single point higher than any other portion thereof. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the cylindrical projections of the transfer tool of the references as combined with either spherical or conical projections because Inagaki et al. shows these to be interchangeable (paragraph 0011). The references as combined fail to discuss the center average height of the projections.

Akemi et al. teaches that the height of projections for preventing an adhesive film from sticking to a surface and the proportion of the surface area comprising the projections vary depending upon the composition of the adhesive (column 4, lines 30-63). Akemi et al. further teaches the preferred height of the projections to be 2 to 1000

μm. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the center average height of the projections of the references as combined greater than 9 μm because Akemi et al. teaches that this range is satisfactory for conventional adhesives. Furthermore, Akemi et al. teaches that the projection height and pitch are result effective variables dependent upon the composition of the adhesive and one of ordinary skill in the art would use routine optimization to determine the appropriate height and load length ratio. The references as combined fail to show the composition of the housing material.

The admitted prior art discloses a transfer tool wherein the housing comprises polystyrene (specification page 6, paragraph 42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the housing of the references as combined of polystyrene because the admitted prior art discloses that this is a common material for transfer tool housings.

Sosa et al. teaches that zinc stearate is a conventional mold release agent added to polystyrene when molding articles (column 1, lines 35-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add zinc stearate to the polystyrene housing of the references as combined because Sosa et al. teaches that zinc stearate is conventionally added to the polymer to allow it to release from the mold.

As to claim 2, the references as combined (see Nose et al.) disclose a transfer tool wherein the ribbon substrate is a tape (see Figure 1, film transfer ribbon R).

As to claim 10, the references as combined are silent as to a transfer tool wherein the entire inner surface of the housing has a roughened surface. When modifying the transfer tool of Nose et al. as noted above to include roughening the interior surface of the housing to prevent the coating film from adhering to the interior surface of the housing, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the housing of Nose et al. to include projections on its entire inner surface to minimize the possibility of having the coating film undesirably adhere to any portion of the housing's interior.

As to claim 11, the references as combined (see Mendelovich et al.) disclose a transfer tool wherein the housing has projections along a path where the ribbon substrate (Figure 7, carrier tape 98) travels inside the housing.

As to claim 12, the references as combined (see Mendelovich et al.) disclose a transfer tool further comprising a dispenser at which the coating film is dispensed from the ribbon substrate, wherein the projections provided on an upstream side of the dispenser.

As to claim 14, injection molding is a conventional method of producing a shaped polymer object.

As to claim 15 the percentage of zinc stearate used would be determined by routine optimization to ensure that the injection molded article releases from the mold.

As to claim 16, the references as combined (see Mendelovich et al.) disclose a transfer tool wherein the projections are formed in a repetition of a predetermined pattern (Figure 7). In any event, it would have been readily apparent to one of ordinary

skill in the art at the time of the invention to select the shape of the projections to form a variety of patterns as an aesthetic design choice.

As to claim 17, the references as combined (see Nose et al.) disclose a transfer tool wherein the coating film is a correction film (column 21, lines 53-54).

As to claim 19, the references as combined (see Nose et al.) disclose a transfer tool wherein the ribbon substrate is formed mainly of polyethylene (column 14, lines 30-32) and has a thickness of about 25 μm (column 10, lines 23-24).

As to claim 22, the references as combined (see Nose et al.) disclose a transfer tool wherein the coating film is about 20 μm in thickness (column 10, lines 25-26).

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nose et al. (US 5,685,944) in view of Mendelovich et al. (US 5,735,999), Inagaki et al., Akemi et al., the admitted prior art and Sosa et al. as applied to claim 1 above, and further in view of Van Hoof et al. (US 3,936,571). The references as combined do not disclose a transfer tool wherein the ribbon substrate is processed for both surfaces to exhibit releasability. It is well known and conventional in the tape dispenser art, as disclosed by Van Hoof et al. (column 3, lines 41-48), to coat one or both sides of a liner carrying an adhesive tape with an anti-adhesion agent to prevent adjacent convolutions of the adhesive tape roll from bonding together, as well as for handling adhesive tapes which have an adhesive layer on both sides. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ribbon substrate of the references as combined to have both surfaces coated with an anti-adhesion agent as

suggested by Van Hoof et al.; coating both sides of a release liner being well established in the art for preventing adjacent convolutions of an adhesive tape roll from bonding together.

4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nose et al. (US 5,685,944) in view of Mendelovich et al. (US 5,735,999), Inagaki et al., Akemi et al. the admitted prior art and Sosa et al. as applied to claim 1 above, and further in view of Yamashita (US 2004/0180196). The references as combined are silent as to the composition of the coating film. Yamashita discloses a transfer tape comprising an emulsion-type acrylic adhesive, a rosin-type tackifier, a phthalocyanine blue colorant, crawling inhibitor, and water, which maintains strong adhesive strength but can be reliably cut at a stipulated position (abstract; page 3, paragraphs 36-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the coating film of the references as combined to include an emulsion-type acrylic adhesive, a rosin-type tackifier, a phthalocyanine blue colorant, crawling inhibitor, and water as suggested by Yamashita to provide a transfer tape which maintains strong adhesive strength but can be reliably cut at a stipulated position.

Response to Arguments

5. Applicant's arguments with respect to claims 1-2, 10-12, 14-17, 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's argument that the projections of Inagaki would not meet the claimed limitation because they project from the adhesive surface is also not persuasive. Applicant is arguing the references separately instead of as a whole. The reference to Akemi et al. teaches that the projections can be provided on the inside of a package facing an adhesive surface (column 2, lines 28-37).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 10:00-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark A Osele/
Primary Examiner, Art Unit 1791

February 19, 2008